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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,686

04/19/2005

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

08/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/524,686	Applicant(s) SHIMIZU ET AL.	
	Examiner Taofiq A. Solola	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-2, 4-5, 7, 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/4/09</u> . | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-2, 4-5, 7, 9 are pending in this application.

Claims 3, 6, 8 are deleted

Request for Continued Examination

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.117(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/4/09 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, 7, 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiroko et al., JP 5078289.

Applicant claims a process of making aminobenzopyran of formula 2, comprising reducing nitrobenzopyran of formula 1 with hydrazine in the presence of a metal catalyst. In preferred embodiments the catalyst is platinum or palladium and the molar equivalent of hydrazine to compound 1, is 2 to 5.

Determination of the scope and content of the prior art (MPEP 2141.01)

Hiroko et al., teach a process of making 4-amino phenoxy naphthalene by reducing 4-nitro phenoxy naphthalene with hydrazine in the presence of platinum or palladium catalyst and the molar equivalent of hydrazine to the nitro compound, is 1.2 to 2. See [0017].

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Ascertainment of the difference between the prior art and the claims (MPEP 2141.02)

The difference between the instant invention and that of Hiroko et al., is that the starting materials are analogous compounds and therefore the products. Also the ratios of hydrazine to the starting reagents are different.

Finding of prima facie obviousness--rational and motivation (MPEP 2142.2413)

However, the use of analogous starting materials in a well-known process is prima facie obvious. *In re Durden*, 226 USPQ 359 (1985). There is no evidence in the specification or the prior arts that any part of the starting reagents other than NO₂ is involved in the reaction process. Changing the molar equivalent of hydrazine to the starting reagent is an obvious modification available to the preference of an artisan, and does not rise to the level of invention under the US patent practice. It is a mere optimization of a variable, which is not patentable absent unexpected result due to the variable, which is different in kind and not merely in degree from that of the prior art. *In re Aller*, 22 F.2d 454, 105 USPG 233 (CCPA, 1955).

Therefore, the instant invention is prima facie obvious from the teaching of the prior art. One of ordinary skill in the art would have known to use analogous starting reagent, at the time the instant process was made. The motivation is from knowing that analogous starting reagents would have similar chemical reactions.

Alternatively, given the teaching of Hiroko et al., it would have been obvious to try reduction of any nitro compound with hydrazine in the presence of platinum or palladium catalyst at the time the invention was made.

When there is motivation

to solve a problem and there are a finite number of identified,
predictable solutions, a person of ordinary skill has good reason to
pursue the known options within his or her technical grasp. If this

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leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under [35 USC] 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct 1727,-----, 82 USPQ2d 1385, 1397 (2007).

Alternatively, given the teaching of Hiroko et al., one would have known to reduce any nitro compound with hydrazine in the presence of platinum or palladium catalyst at the time the invention was made. "When a work is available in one field of endeavour, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technology is obvious unless its actual application is beyond his or her skill." "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims." *KSR Int. Co. v. Teleflex Inc*, 550 U.S. ----, 82 USPQ2d 1385 (2007).

Alternatively, applicant has done nothing more than substitutes analogous starting reagents in a well known process. However, such substitution is obvious from the prior art. "When a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *United States v. Adams*, 383 U.S. 49, 50-51 (1966). Cited in *KSR Int. Co. v. Teleflex Inc*, 550 U.S. ----, 82 USPQ2d 1385 (2007). The combination of familiar

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elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR, supra*.

This is RCE of the same application. All claims are drawn to the same invention claimed in the earlier application and have been finally rejected on the grounds and art of record.

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

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/Taofiq A. Solola/

Primary Examiner, Art Unit 1625

July 28, 2009